

REMARKS

Claims 1-26 are pending. By this Amendment, claims 1, 8, 15 and 23 are amended and new claim 27 is added are added. The amendments to claims 1, 8, 15 and 23 are supported by the specification at, for example, pages 21-22, and by the originally filed claims. New claim 27 is supported by the specification at, for example, pages 21-25. No new matter is introduced by the present Amendment.

Claims 1-3, 5-10, 12-17 and 19-25 stand as rejected, and claims 4, 11, 18 and 26 are objected to as depending from a rejected base claim, but would be allowable if rewritten in independent form. Applicants respectfully request reconsideration of the rejection based upon the following remarks.

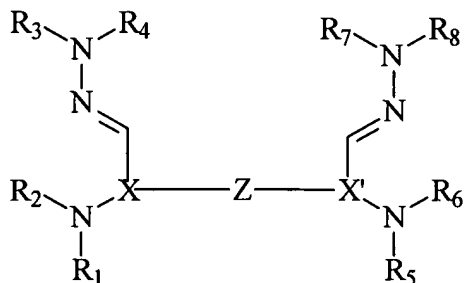
Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1-3, 5-10, 12-17 and 19-25 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner asserted that the term “part of a cyclic ring” is indefinite. “The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” See MPEP § 2173.02 (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081, 1088 (Fed.Cir 1986)). Applicants submit that one of skill in the art would understand that “part of cyclic ring” refers to an atom or group that is bonded to other atoms or groups in a ring system. For example, a carbon atom in a benzyl group is part of cyclic ring. Since one of ordinary skill in the art would understand what “part of cyclic ring” means, the term “part of a cyclic ring” is definite. As such, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 5-10, 12-17 and 19-25 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1-3, 5-7 and 23-25 under 35 U.S.C. § 102(b) as being anticipated by EP 511 664 (the '664 reference). More specifically, the Examiner asserted that the '664 reference "discloses charge transport compounds (3-1) through (3-8), (3-14), (3-17), (3-18), and (3-2) that meet the requirements of the charge transport compounds of the instant claims." Applicants submit that the '664 reference does not prima facie anticipate Applicants' invention, as presently claimed in independent claims 1, 8, 15 and 23. Applicants respectfully request reconsideration of the rejection based upon the following comments.

The '664 reference does not disclose a charge transport material having a linking group comprising a divalent linking group having the formula $-(CH_2)_m-$, branched or linear, wherein m is an integer between 1 and 30, inclusive, and wherein one or more methylene groups is replaced by S, C=O, O=S=O, a heterocyclic group, urethane, urea, an ester group, a NR_9 group a CHR_{13} group, a $CR_{14}R_{15}$ group where R_{13} , R_{14} and R_{15} are independently hydroxyl, thiol, an alkoxy group or an alkyl group. In contrast, Applicants invention, as claimed in independent claims 1 and 23, relates to a charge transport material having the formula



where Z comprises a divalent linking group having the formula $-(CH_2)_m-$, branched or linear, wherein m is an integer between 1 and 30, inclusive, and wherein one or more methylene groups

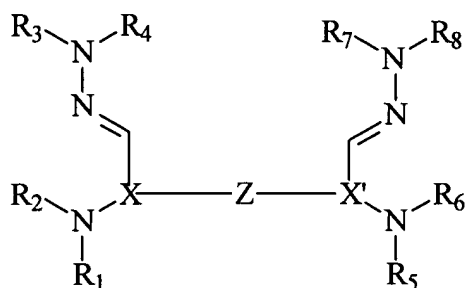
is replaced by S, C=O, O=S=O, a heterocyclic group, urethane, urea, an ester group, a NR_9 group a CHR_{13} group, a $\text{CR}_{14}\text{R}_{15}$ group where R_{13} , R_{14} and R_{15} are independently hydroxyl, thiol, an alkoxy group or an alkyl group. Since the '664 reference does not disclose this feature of Applicants' claimed invention, the '664 reference does not prima facie anticipate Applicants' invention, as presently claimed in independent claims 1 and 23.

Since the '664 reference does not prima facie anticipate Applicants' claimed invention, Applicants respectfully request withdrawal of the rejection of claims 1-3, 5-7 and 23-25 under 35 U.S.C. § 102(b) as being anticipated by the '664 reference.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 8-10, 12-17, and 19-22 under 35 U.S.C. § 103(a) as being unpatentable over the '664 reference in view of Handbook of Imaging Materials, pp. 145-164 and 239-242. Claims 8-10, 12-17 and 19-22 depend, respectively, from independent claims 1, 8 and 15, and therefore incorporate all of the features of the respective independent claim. As discussed above, the '664 reference does not disclose or suggest a charge transport material having a linking group comprising a divalent linking group having the formula $-(\text{CH}_2)_m-$, branched or linear, wherein m is an integer between 1 and 30, inclusive, and wherein one or more methylene groups is replaced by S, C=O, O=S=O, a heterocyclic group, urethane, urea, an ester group, a NR_9 group a CHR_{13} group, a $\text{CR}_{14}\text{R}_{15}$ group where R_{13} , R_{14} and R_{15} are independently hydroxyl, thiol, an alkoxy group or an alkyl group. Additionally, the Handbook of Imaging Materials, pp. 145-164 and 239-242, does not disclose or suggest a charge transport

material having the claimed linking group. In contrast, Applicants invention, as claimed in independent claims 1, 8 and 15, relates to a charge transport material having the formula



where Z comprises a divalent linking group having the formula $-(CH_2)_m-$, branched or linear, wherein m is an integer between 1 and 30, inclusive, and wherein one or more methylene groups is replaced by S, C=O, O=S=O, a heterocyclic group, urethane, urea, an ester group, a NR_9 group, a CHR_{13} group, a $CR_{14}R_{15}$ group where R_{13} , R_{14} and R_{15} are independently hydroxyl, thiol, an alkoxy group or an alkyl group. Since neither the '664 reference nor the Handbook of Imaging materials, pp. 145-164 and 239-242, disclose or suggest this feature of Applicants' claimed invention, the combination of the '664 reference and the Handbook of Imaging materials, pp. 145-164 and 239-242, does not render Applicants' invention, as presently claimed in independent claims 1, 8 and 15, prima facie obvious. Therefore, Applicants respectfully request the withdrawal of the rejection of claims 8-10, 12-17, and 19-22 under 35 U.S.C. § 103(a) as being unpatentable over the '664 reference in view of Handbook of Imaging Materials, pp. 145-164 and 239-242.

Applicants do not comment further on specific features of the dependent claims, although Applicants do not acquiesce in the assertions in the office action, since these issues are presently moot in light of the above analysis.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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